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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,696

02/18/2004

Erwin Simnacher

69643.001500

9538

21967 7590 09/10/2009

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EXAMINER

MEHTA, PARIKHA SOLANKI

ART UNIT

PAPER NUMBER

3737

MAIL DATE

DELIVERY MODE

09/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/779,696	<b>Applicant(s)</b> SIMNACHER, ERWIN	
	<b>Examiner</b> PARIKHA S. MEHTA	<b>Art Unit</b> 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 July 2009 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eizenhoefer (US Patent No. 5,119,801), hereinafter Eizenhoefer ('801), of record, in view of Hagood (US Patent No. 5,869,189), hereinafter Hagood ('189), of record.

Eizenhoefer ('801) teaches a medical shock wave apparatus comprising piezoelectric fibers integrated in a material in a lengthwise direction between respective electrical terminals, a voltage source connected to at least one terminal, a coupling membrane defining a volume filled with a shock wave transmission fluid between the fibers and the membrane, a curved planar carrier having a conductive portion coupled to multiple modules of fiber, the modules including fibers with a common electrical contact, wherein the modules are controllable as a module group (Fig. 1, col. 2 line 62 – col. 3 line 55). Eizenhoefer ('801) does not expressly teach the material to be composite. In the same field of endeavor, Hagood ('189) teaches a medical ultrasonic transducer wherein multiple piezoelectric fibers are integrated in a composite material (col. 2 lines 1-10). It would have been obvious to one of ordinary skill in the art at the time of invention to have substituted the composite material of Hagood ('189) for the material of Eizenhoefer ('801), as a skilled artisan would expect the apparatus of Eizenhoefer ('801) to work equally well with a composite material, and such modification would require nothing more than the mere

Art Unit: 3737

combination of known prior art elements to yield predictable results, which has previously been held as obvious and unpatentable (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385).

### ***Response to Arguments***

4. Applicant's arguments filed 30 July 2009 have been fully considered but they are not persuasive.

Applicant argues that Eizenhoefer ('801) lacks piezoelectric fibers as claimed (Remarks p. 5). As Applicant has failed to adequately redefine the term "fiber" in the present disclosure so as to put a skilled artisan on reasonable notice that the term is used therein to mean something other than its ordinary meaning in the art (*Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).), the term is interpreted to encompass any "element that gives structure or substance" (Merriam Webster), which is reasonably satisfied by the elements of Eizenhoefer ('801). Furthermore, even if Applicant were to effectively distinguish the claimed fiber from the element of Eizenhoefer ('801), the element is taught by Hagood ('189) and would be reasonably combined with Eizenhoefer ('801) to yield such an invention. Accordingly, Applicant's arguments are unpersuasive.

Applicant also argues that Eizenhoefer ('801) fails to embed the piezoelectric elements in a composite or solid. Examiner notes that Eizenhoefer ('801) was not relied upon to teach this feature; Eizenhoefer ('801) generally teaches the embedding of the elements in a material (see col. 3 lines 5-6), which, when combined with the specific composite embedding material of Hagood ('189), yields the present invention. Accordingly, Applicant's arguments are not persuasive.

Applicant further contends that Eizenhoefer ('801) and Hagood ('189) are not of the same field of endeavor because they are not both directed towards shockwave transmission, and further suggests that the references were combined using impermissible hindsight (Remarks p. 6). Examiner maintains that, because both references are directed towards the transmission of ultrasonic energy, they are in fact of the same field of endeavor. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that Hagood ('189) cannot teach the presently claimed fibers because the reference does not teach them as generating shockwaves (Remarks p. 6). The present claims recite the

Art Unit: 3737

generation of shockwaves as nothing more than a limitation placed upon the intended use of the invention in the preamble, and although the claim also recites a "shockwave transmission medium", such recitation does not positively limit the structure to a shockwave generator; it merely requires at least part of the device to be capable of transmitting an arbitrary shockwave. Accordingly, Applicant's arguments are unpersuasive.

Applicant suggests that, because Eizenhoefer ('801) purportedly teaches inclusion of a gap between the piezoelectric elements and the surrounding material, the reference teaches away from embedding the elements in a solid or composite (Remarks p. 7). Without acquiescing to Applicant's allegations regarding the interpretation of Eizenhoefer ('801), Examiner notes that the claims do not limit the present structure to one excluding gaps, and therefore Applicant's arguments are moot.

As Applicant's arguments are wholly unpersuasive to overcome the previous rejection for at least the foregoing reasons, such rejection is maintained and reiterated herein.

### *Conclusion*

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARIKHA S. MEHTA whose telephone number is (571)272-3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

Art Unit: 3737

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/  
Supervisory Patent Examiner, Art Unit  
3737

/Parikha S Mehta/  
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